



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ferguson

Serial No.: 09/852,519

Group No.: 1617

Filed: May 10, 2001

Examiner: S. Sharareh

For: MORE EASILY VISUALIZED PUNCTUM PLUG CONFIGURATIONS

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RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed March 26, 2003, the Examiner's attention is directed to the following remarks.

REMARKS

Applicant continues to traverse the election of Group I, and is filing herewith a petition to have claims 9-21 examined in this case. It is the Examiner's opinion that claim 9 could be practiced by other systems where no optical element is required. It does not matter what the application "admits," only what the claims actually set forth. Given that claim 9 includes a limitation of "the punctum plug of claim 1," and an optical element, the claims should properly be examined.

Claims 1-8 stand rejected under 35 U.S.C. §112, second paragraph, as being "indefinite." The Examiner believes that use of the term "more easily" is relative because it is not defined by the claim, and the specification does not provide a standard for ascertaining requisite degree ... The Examiner is wrong on this point as well. If Applicant had simply used "more easily" without making reference to any other point of comparison, the Examiner might be correct. In this case, however, the Examiner specifically states that by virtue of the claimed invention, the punctum plug is more easily visualized *than if the substance were not present*. Thus, anyone of ordinary skill in the art would reasonably be apprised as to the scope of the invention.

Claims 1-4 and 6 stand rejected under 35 U.S.C. §102(b) by L'Esperance, Jr., U.S. Patent No. 5,300,020. However, the Examiner is clearly misinterpreting the L'Esperance reference, and applying